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PATENT APPLICATION

RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER ART UNIT 2834

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Ko YOSHIDA et al.

Group Art Unit: 2834

Application No.: 09/740,038

Examiner: T. Lam

Filed: December 20, 2000

Docket No.: 111340

For: ROTARY ELECTRIC MACHINE WITH STATOR ELASTIC SUPPORT
STRUCTURE

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

Director of the U.S. Patent and Trademark Office
Washington, D.C. 20231

Sir:

In reply to the November 7, 2002 Office Action, reconsideration of the application is respectfully requested in light of the following remarks. Claims 1 and 3-18 are pending in this application. Claims 4-17 are withdrawn as being drawn to a non-elected species.

Applicants respectfully request the withdrawal of the Election Requirement and allowance of claims 4-17. Upon allowance of claim 1 withdrawn claims 4-14 must be allowed as they depend from independent claim 1. Further, upon allowance of generic claim 1, withdrawn claims 15-17 should also be allowed because Applicants are entitled to allowance of claims directed toward a reasonable number of species (37 CFR 1.41(a)).

Claims 1, 3 and 18 are rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,998,902 to Umeda et al. (Umeda) in view of JP 40-6225485A to Ishihara et al. (Ishihara). The rejection is respectfully traversed.

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The Office Action alleges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify and utilize the stator core and frame of Umeda by inserting the elastic member of Ishihara. However, a statement that modifications of the prior art to meet the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made, because the references relied upon teach all aspects of the claimed invention were individually known in the art, is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd Pat. App. & Inter. 1993).

Applicants assert that there is no objective reason to combine the teachings of the references. For example, Umeda addresses a problem different from that addressed by Ishihara and the instant application. Specifically, Umeda discloses reducing the size of an alternator without reducing the efficiency, and reducing the magnetic noise between the rotor and the stator. Umeda discloses reducing the magnetic noise between the stator and the rotor by installing the electric conductors in a first conductor group at an electric angle of approximately 30° to a second conductor group, thus reducing the magnetic ripple force causing the magnetic noise (col. 7, lines 49-58; col. 16, lines 54-57). Accordingly, there is no suggestion or motivation in Umeda to combine the teachings of Ishihara to dampen vibration between the stator core and the frame.

In Ishihara, the stated purpose is to reduce the level of magnetic noise transferred to the frame by the vibration of the stator core. Therefore, there is no objective reason in Ishihara to combine the elastic member disclosed therein with Umeda whose stated goal is to reduce the size of an alternator while reducing the magnetic noise between the rotor and the stator.

Furthermore, the fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so (MPEP §2143.01).

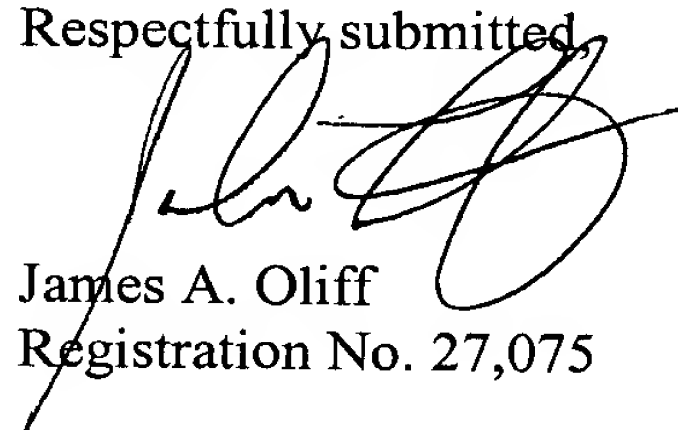
Even though it may be possible to combine the teachings of Umeda with Ishihara, Applicants assert that the desirability of such a combination is not suggested in either of the applied references. For example, there is no suggestion in Umeda that it is desirable to reduce the level of magnetic noise between the stator core and the frame, by introducing an elastic member between the stator core and the frame. Nor is there any suggestion in Ishihara that it is desirable to reduce the level of noise between the stator and the rotor.

Additionally, even were Ishihara combined with Umeda, the heat generated by the stator core 13 of Ishihara would not be sufficiently radiated, thereby deteriorating the elastic member 15. Accordingly, the vibration of the stator core 13 to the third bracket 16 would be increased. Thus, Applicants assert that because the heat induced deterioration of the elastic member 15 is not contemplated by Ishihara, there is no motivation to combine the references without the impermissible use of hindsight. Accordingly, Applicants respectfully request the rejection of claims 1, 3 and 18 under 35 U.S.C. §103(a) be withdrawn.

In view of the foregoing, reconsideration of the application is respectfully requested. It is submitted that the claims as previously presented patentably distinguish over the applied references and fully meets the requirements of 35 U.S.C. §112. Accordingly, allowance of claims 1, 3 and 18, as well as rejoinder allowance of withdrawn claims 4-17, is respectfully solicited.

Should the Examiner believe that anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,



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Date: January 21, 2003

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